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REMARKS

Claims 1-26 are pending. Applicant requests reconsideration in light of the following remarks. Applicant requests withdrawal of the outstanding rejections, and allowance of the claims.

In the outstanding office action the Examiner rejected claims 25 and 26 under 35 U.S.C. §112, first paragraph, for lack of enablement, citing lack of support in the specification for those two claims. Even though Applicant did not change the claims in the previously filed amendment, and the Examiner had an opportunity to make this rejection in his first office action, this is a final rejection. Applicant has amended the specification to include specific support for claims 25 and 26. Support for this amendment is in the originally filed application at page 2, lines 7-10, and in the originally filed claims 25 and 26. By entering this amendment the Examiner will be reducing an outstanding issue in this application, namely the rejection under 35 U.S.C. §112.

In the outstanding office action, the Examiner rejected claims 1, 3, 9, 11, 17, and 19 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. Des. 347,900 to Stapleton (the "Stapleton" reference) in view of U.S. Patent No. Des. 417,513 to Blanpied (the "Blanpied" reference). As admitted by the Examiner, the combination of Stapleton and Blanpied fails to include one of the elements of Applicant's claims, namely the provision that each tab is substantially uniform in color. The Examiner states that this element is not critical to the invention, and is merely a design choice. Applicant disagrees. The entire purpose of the invention is to make a collection of shingles look like a slate roof. Hence, the title of the application is: SHINGLE FOR OPTICALLY SIMULATING A SLATE ROOF. The commercial value of natural slate roofs in the market place and the overall goal of mimicking slate roofs is explained in the specification at page 1, lines 24-26, and at page 2, lines 1-3.

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Nothing could be more critical for making the shingles look like slate tiles than the concept of having each tab be of a uniform color. This is set forth very specifically at page 5, lines 19 through page 6, line 2. Also, all the drawings show tabs of uniform color. Further, the slate roof designs in U.S. Patent 6,253,512, which is incorporated by reference into the present application, all show slate tiles of uniform color. Anyone skilled in the art would recognize that any arrangement by which the tabs would be NOT of uniform color would result in a roof that does not look like a slate roof. Natural slate does not have cutouts between different slate tiles. Such a configuration would not look like a slate roof. Without uniform colored tabs, the shingles would simply not look like a slate roof, and the objective of the invention would be defeated. Since the Examiner's combination of the Stapleton and Blanpied references fails to include the concept of having each tab be of a uniform color, which is a critical element of the invention, the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. §103(a). Accordingly, Applicant requests withdrawal of the rejection.

In the outstanding office action, the Examiner rejected claims 2, 4-6, 12, 13, 15, 16, 18, 20, 21, 22 and 24 under 35 U.S.C. §103 as being unpatentable over Stapleton in view of U.S. Patent No. 6,014,847 to Phillips (the "Phillips" reference). Because all these claims ultimately depend on independent claims 1, 9 and 17, for at least this reason these dependent claims, i.e., claims 2, 4-6, 12, 13, 15, 16, 18, 20, 21, 22 and 24, are also patentable over the combination of Stapleton and Phillips. Therefore, Applicant requests withdrawal of the rejection of claims 2, 4-6, 12, 13, 15, 16, 18, 20, 21, 22 and 24 under 35 U.S.C. §103.

The Examiner also rejected claims 7, 14 and 23 under 35 U.S.C. §103(a) as being unpatentable over Stapleton in view of Phillips and further in view of U.S. Patent No. 6,105,329 to Bondoc (hereinafter, the Bondoc patent). Because all these claims ultimately depend on independent claims 1, 9 and 17,

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for at least this reason dependent claims 7, 14 and 23 are also patentable over the combination of Stapleton and Phillips. Therefore, Applicant requests withdrawal of the rejection of claims 7, 14 and 23 under 35 U.S.C. §103.

In conclusion, Applicant has shown that the rejection of independent claims 1, 9 and 17 fails to make a *prima facie* case of obviousness under 35 U.S.C. §103(a), and therefore those claims and all claims dependent on those claims are patentable. Further, Applicant's amendment of the specification to include a specific reference to the limitations of claims 25 and 26 in the Detailed Description and Preferred Embodiments of the Invention obviates the rejection under 35 U.S.C. §112, thereby eliminating the sole rejection of those claims. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections of record, and allowance of all claims.

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Specification

Replace the paragraph beginning on page 6, line 3 with the following new paragraph:

Although it is shown that the color blend for a particular tab 20 is applied to the tab 20 and the headlap portion 16 of the overlay member 12, it will be appreciated that less expensive dark or black granules may be applied to the headlap portion 16, rather than the more expensive color granules because the headlap portion 16 will be covered when overlapping successive course of shingles 10 are applied to the roof. In addition, each tab 20 may consist of the same or different color blend that corresponds to a color in a particular pattern unit, as described in co-assigned [, co-pending] U.S. Patent No. 6,253,512 [Application Serial No.09/292,488 filed on April 14, 1999], herein incorporated by reference. Applying shingles to the roof using a particular pattern provides for an attractive, aesthetically pleasing roof appearance.